REMARKS

Status of the claims:

With the above amendment, claim 8 has been canceled and claims 30 and 35 have been amended. Thus, claims 1, 3-7, 26-33, and 35-38 are pending with claims 1, 3-7, 30-33, 35, and 38 being ready for further action on the merits. No new matter has been added by way of the above amendments. Claim 30 has been amended to correct its dependency and claim 35 has been made independent. Reconsideration is respectfully requested in light of the following remarks.

Claim Objections

Claim 8 is objected to under 37 CFR §1.75 for failing to further limit claim 7. claim 8 has been canceled so the objection is moot. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §112, first paragraph

Claims 1, 3-6, 30-33, 35 and 38 are rejected under 35 USC §112, first paragraph as allegedly not being enabled.

Applicants traverse.

Applicants submit that one of skill in the art could make and use the invention commensurate in scope with the rejected claims without undue experimentation.

Applicants submit that claim 1 and all claims dependent therefrom are enabled for their full scope. In particular, Applicants have described an assay that would allow one of skill in the art to screen for a protein having anti-angiogenic activity and have also described an assay for showing that the protein binds the N-terminal fragment of plasminogen (but does not cleave it). The Examiner's attention is drawn to the following passages where this is described: page 8, lines 6-14, page 10, lines 4-14 and page 11, lines 21-28. Thus, Applicants submit that one could make and use the invention commensurate in scope with the claimed invention without undue experimentation. Moreover, after such protein is identified, a binding assay can be done wherein the protein can be screened for binding with the N-terminal fragment of plasminogen and then visualized on a gel as is shown in figure 4.

Regarding screeing, the Court of Appeals for the Federal Circuit in *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) stated

> *Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation'.*

Applicants establish below that the amount of experimentation needed to practice the full-scope of the claimed

invention is not 'undue'. Therefore, the present claims should be considered enabled by the present specification.

Moreover, Applicants submit that the Examiner has failed to meet the burden of presenting a *prima facie* case as to why the claims would not be enabled. See *In re Wright*, 27 USPQ2d 1510 (Fed. Cir. 1993). *Wright*, citing *In re Marzocchi*, 169 USPQ 367, 369 *(CCPA 1971)* states

> *When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.*

The Examiner has failed to meet this initial burden. Even if the Examiner had met this burden, Applicants have provided an example that works. Absent some evidence from the Examiner that other proteins would not work, one must assume that the full scope of the claimed invention is enabled by the specification. Consequently, Applicants submit that the claims are enabled for the full scope of the invention.

Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required fee of $930.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 8 has been canceled.

The claims have been amended as follows.

30. (Three times amended) A composition comprising a protein or peptide according to any one of claims 1 or 3-7 [3-8] together with a pharmaceutically acceptable carrier wherein said protein or said peptide does not cleave plasminogen kringle domains.

35. (Amended) [The protein of claim 34] An isolated human protein having anti-angiogenic activity and that is a receptor for an N-terminal fragment of plasminogen comprising kringle domains 1-4 and/or 5 and [an amino acid sequence] wherein said protein comprises SEQ ID No: 4 and has sequence homology equal to or greater than 80% to SEQ ID Nos: 2 or 3.